

REMARKS

I. Status of Claims

Claims 1-33 are pending. Claims 8-23 are withdrawn. Claims 1-7 and 24-33 are rejected. The Examiner clarified and replaced the prior restriction requirement with a lack of unity requirement. Applicant reiterates its desire to pursue Group I claims 1-7 and 24-33, but now elects these claims without traverse. Should any of these claims be found generic and allowed, it is noted that the Applicant is entitled to a reasonable number of species. The Examiner is respectfully requested to reconsider this election requirement if such a claim is found.

II. §103 Rejection

Claims 1-7 and 24-33 are rejected under 35 USC 103 as being unpatentable over either Morikawa (JP-63-278889) or Kanzaki et al. (JP02-20379) in view of any of Kronzer '902 (US5,501,902), Kronzer '179 (US5,798,179) or Cole et al. (US 6,582,803). The Examiner states the primary references teach thermal donor webs having a substrate, a layer of transferable thermal material and detection marks for determining the location of the printing material on the webs. The Examiner further states that the secondary references teach that ink jet indicia are conventionally applied to thermal donor webs. The Examiner concludes that the use of the secondary reference ink jet indicia as the generically disclose indicia of the primary references would have been obvious to one of ordinary skill in the art.

Applicant traverse the rejection and contend that a *prima facie* case of

obviousness has not been made. The references fail to teach or suggest the problem solved by the present invention. Specifically, the references fail to teach or suggest that a clear foil used in the present invention has physical properties much different than other web type material making it difficult to print the indicia on the foil. This difference in physical properties actually resists or prohibits the use of printed indicia as disclosed in the application to indicate the length remaining or the roll or use of the sheeting material.

When considering obviousness of a combination of elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions." KSR International Co. v. Teleflex Inc., 550 U.S. –, 82 USPQ2d 1385, 1396 (2007). In the present invention the improvement is more than what is predicted because printing indicia would not have been possible otherwise.

In addition, it is well settled that "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006). Merely picking elements from references to recreate the applicants' invention is not sufficient for a ground of obviousness.

For at least these reasons, reconsideration and withdrawal of the rejections is respectfully requested.

CONCLUSION

Based on the foregoing remarks, it is respectfully submitted that the claims as currently pending are patentable and in condition for allowance.

If any issues remain, or if the Examiner has any suggestions for expediting allowance of this application, the examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Favorable consideration is respectfully requested.

AUTHORIZATION

The Assistant Commissioner is hereby authorized to charge any additional fees that may be required for this response to Deposit Account **13-4500**, Order No. **4758-4101US1**, and is hereby petitioned for any extension of time that may be required to make this response timely. **A DUPLICATE OF THIS SHEET IS ATTACHED.**

Respectfully submitted,
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